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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,383	09/11/2003	Hiroshi Hasegawa	14381Z	6917
23389	7590	08/26/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			CAMPBELL, THOR S	
			ART UNIT	PAPER NUMBER
			3742	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,383

Applicant(s)

HASEGAWA ET AL.

Examiner

Thor S. Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 and 74-83 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/808,807.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/11/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-72, and 74-77, 81-83 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-77, and 81-82 of copending Application No. 09/808807. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application are merely broader in scope than the claims of 09/808807. The scope is broadened only by the omission of the "angling input unit" of the parent case. The narrower claim anticipates the broad claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Hasegawa et al. (US 6371907) in view of JP 58-172905

Hasegawa discloses the claimed endoscope system including an elongate, flexible insertion portion that has a curving portion capable of curving and that can be inserted into a cavity; a drum portion connected to the proximal end of said insertion portion, said drum portion having a rotatable drum body and a drum fulcrum by which said drum body is rotatably held, said drum body having a cylindrical portion and side portions, said side portions configured to block openings in both sides of said cylindrical portion, said cylindrical portion containing a through hole in which the proximal end of said insertion portion is passed therethrough; an illumination optical system provided in a tip portion of said insertion portion and configured to emit illumination light from a light source device contained within said drum body; an imaging optical system provided in said tip portion of said insertion portion and configured to provide images of an object illuminated by said illumination optical system; a signal processing device, contained within said drum body, configured to perform signal processing functions on images from said imaging optical system and to generate a video signal; manipulation wires that are inserted in an axial direction of said insertion portion and that make said curving portion curve by moving in the axial direction; a drive motor that is provided on at least one of said cylindrical portion and side portions of said drum body, said drive motor making said curving portion curve by moving said manipulation wires; a fixing member provided in

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said drum body, by which the position of said drive motor is fixed with respect to the position of the proximal end of said insertion portion, said fixing member being fixed to at least one of said cylindrical portion and said side portion of said drum body; a signal cable which is extended from the inside to the outside through said drum body and said drum fulcrum; and curving manipulation means for performing curving manipulation of said curving portion by controlling drive motion of said drive motor, said curving manipulation means being connected to an end of said signal cable which extends from said drum portion. Hasegawa does not disclose an endoscope stowage case in which the drum is stowed.

JP 58-172905 discloses a case for an endoscope system including a drum for winding an endoscope thereabout. It would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of JP 58-172905, to modify the device of Hasegawa to include a case to stow the endoscope system in order to make the entire system more portable and to protect the endoscope system from damage while not in use.

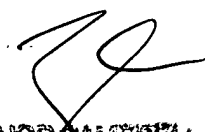
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thor S. Campbell whose telephone number is 703-306-9042. The examiner can normally be reached on Tue-Fri 5:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans can be reached on 703-305-5766. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TSC
8/3/04


THOMAS CAMPBELL
PATENT EXAMINER